



UNITED STATES DEPARTMENT OF COMMERCE
Pat nt and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/060,047	04/14/98	DUNN	R 8905.157US01

HM12/0829
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, PA
P.O. BOX 2938
MINNEAPOLIS MN 55402

EXAMINER

WEBMAN, E

ART UNIT

PAPER NUMBER

1617

DATE MAILED:

08/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/060047

Applicant(s)

DUNN

Examiner

WEGMAN

Group/Art Unit

1617

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/14/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-3, 14, 15, 19, 28, 29 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3, 14, 15, 19, 28, 29 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1617

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 14, 15, 19, 28, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by.

'481 teaches incorporating an active agent into a controlled release component and combining that component with a liquid polymer system (page 4 lines 26-34). An emulsion formed by addition of an aqueous carrier containing an active agent to a liquid prepolymer is disclosed (page 12 line 29, page 13, line 9). Suitable polymers, including polylactides, (page 21 lines 21-35), Solvents including propylene carbonate, (page 22-23) and active agents, including ⁿanti-inflammatory agents, (pages 25-28) are disclosed. Release modifiers are specified (page 30 lines 8-16).

Applicants disclose propylene carbonate on page 13 lines 24-25. ~~A mixture of~~ ^A applicants argue that '481 teaches particulate carriers, however the active agent contained by such particulate^s lies within the aqueous carrier cited above.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Art Unit: 1617

Claims 1-3, 14, 15, 19, 28, 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Brodbeck et al.

Brodbeck et al teach an active agent in an emulsifying agent dispersed in a gel comprising a polymer and a solvent whose miscibility in water is less than 20% (column 5 lines 35-45, column 6 lines 46-69). Polylactides are specified (column 10, line 67). Water is disclosed (column 18 line 60). Any pharmaceutical, including ~~and~~ antinflammatory, is specified (column 19 lines 31-32, 55-56). Agents that modulate water solubility of the active are disclosed (column ¹⁵ lines 31-49).

No claims allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Webman whose telephone number is (703) -308-4432. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, M. Moezie, can be reached on (703) -308-0570. The fax phone number for the organization where this application or proceeding is assigned is (703) -305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) -308-1235.

Webman/LR

August 1, 2001


EDWARD J. WEBMAN
PRIMARY EXAMINER
GROUP 1500